UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,259	11/23/1999	JAMES D. MARKS	3042/0G691	3586

7590 06/06/2006

DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER	
JEANTY, ROMAIN	

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/447,259	MARKS ET AL.	
	Examiner	Art Unit	
	Romain Jeanty	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/7/2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,6-9,40,43-49,52,54-57,88,91-98 and 103-208* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4, 6-9, 40, 43-49, 52, 54-57, 88, 91-98,103-208* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

1. This Final Office Action is in response to the communication received March 7, 2006. In the communication, applicants elected claims 1, 4, 6 - 9, 40, 43 - 49, 52, 54 - 57, 88, 91 - 98, 103 - 161, 164 - 18 1, 184 - 194, 201 - 205 and 208, with traverse, and withdrew the unelected claims 209-215, from consideration.

Applicant's argument with respect to unelected claims 209-215 is not found to be persuasive in the last Office Action is found to be persuasive. Applicant argued the Restriction on the basis that by claim 88 in claim Group I and by claim 215 in claim Group II can not fairly be characterized as subcombinations which are usable together in a single combination and do not overlap in scope. In response, the respectfully disagrees because the claims of group II present comprise limitations that are different than claim 88 (i.e. a display component configured ...) which presents a burden on the examiner.

The pending claims now are 1, 4, 6 - 9, 40, 43- 49, 52, 54 - 57, 88, 91 - 98, 103 - 161, 164-18 1, 184-194, 201-205, and 208.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 4, 40, 43-45, 49, 52, 88, 91-92, 97-98, 103-128, 132-147, 149-154, 156-168, 172, 176-189, 194-197, 199, and 201-208 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Dworkin et al (Hereinafter refereed to as Dworkin) in view of Uyama (U.S. Patent No. 5,819,267).

As per claims 1, 43-45, 49, 52, 91-92, 97-98, 119, 132-133, 137-138, 141-143, 146-147, 149-153, 156-157, 164, 166, 176, 185, 194, 199, 205, Dworkin discloses a system that provides answers from experts to questions posed by users (col. 3, lines 1 -7). The question and answer system is administered by a page or sites. The three site pages are three distinct fora because each is located at a separate site locations and each permit exchange of information between user and expert on each page. A11 three sites have at least one expert in common (medical expert" as seen in the central portion of FIG. 7).

receiving the questions at the server (5) from the one of the users located at computers la and lb (column 3, lines 22-24), the questions are routed to the expert either based on explicit request of the user or automated processing of the question (col. 7, lines 1 0- 1 3), the expert interface is interface is a telephone which notifies the expert of the question. Note column 7, lines 10-13). Figure 6 shows a series of openly available questions which are posted by the users of the system, the expert issues a command, via the telephone which is a response to the question. The answer is transcribed from verbal form to written and graphical form "note transcriber 7", and posted on each of the three distinct fora of Figures 7, 8 and 9.

Dworkin does not explicitly disclose executing a command from the expert automatically. Uyama in the same of endeavor discloses the concept of processing a reply automatically from an expert (consultant) (i.e., processing replies implies involving a command from the selected expert (the consultant answering the question) (col. 3,lines 20-22). It would have been obvious to person of ordinary skill in the art at the time the

invention was made to modify the disclosures of Dworkin to incorporate processing replies which implies involving a command from the selected expert as evidenced by Uyama in order to make it easy for expert respondents to provide answers to questions.

As per claim 4, Dworkin further discloses wherein receiving a command includes receiving a command to post an answer to the questions. Note the abstract.

As per claim 40, Dworkin discloses a system that provides answers from experts to questions posed by users (col. 3, lines 1 -7). The question and answer system is administered by a pages or sites. The three site pages are three distinct fora because each is located at a separate site locations and each permit exchange of information between user and expert on each page. A11 three sites have at least one expert in common (medical expert" as seen in the central portion of FIG. 7).

receiving the questions at the server (5) from the one of the users located at computers la and lb (column 3, lines 22-24), the questions are routed to the expert either based on explicit request of the user or automated processing of the question (col. 7, lines 1 0- 1 3), the expert interface is interface is a telephone which notifies the expert of the question. Note column 7, lines 10-13). Figure 6 shows a series of openly available questions which are posted by the users of the system, the expert issues a command, via the telephone which is a response to the question. The answer is transcribed from verbal form to written and graphical form "note transcriber 7", and posted on each of the three distinct fora of Figures 7, 8 and 9.

Dworkin does not explicitly disclose executing a command from the expert automatically. Uyama in the same of endeavor discloses the concept of processing a reply automatically from an expert (consultant) (i.e., processing replies implies involving a

command from the selected expert (the consultant answering the question) (col. 3,lines 20-22). It would have been obvious to person of ordinary skill in the art at the time the invention was made to modify the disclosures of Dworkin to incorporate processing replies which implies involving a command from the selected expert as evidenced by Uyama in order to make it easy for expert respondents to provide answers to questions.

Claims 88, and 209 recite the same limitations as claim 1 above except for the limitation of transmitting component configured to transmit the question from the client interface to the server. In addition, Dworkin teaches such transmitting step. Note col. 6, lines 40-50 of Dworkin.

As per claim 103, 108-109, 111, 116-117, 121, 125-126, 134, 143, 154, 158, 162-163, 177, 180, 182-183, 185, 195-197, 199, 202, 206-207, as seen in FIG. 7, each question includes a source field which is the field identifying who submitted. In FIG. 7, the source field "Submitted By" identifies "Joe Ross, M.D." as the submitter.

As per claims 104-107, 110, 114-115, 118, 120, 124, 127-128, 165, 167, 180-184, 186-188, 201, 205, 208, strictly speaking, each user interface (1a) and (1b) is also a forum because a forum requires nothing more that an interface between two people. Since each user interface allows communication between the user and the expert, each user interface creates a separate forum. In this instance, questions will be directed to the expert from different fora.

As per claims 112-113, 122-123, 135-136, 138-140, 144-145, 159-161, 168, 172, 178-179, 181, 184, 189, 203-204, answers are posted to the question each of a plurality of for a (FIG. 7-9 respectively). The answers are posted at substantially the same time, that particular time being after the expert has transcribed a response.

4. Claims 6-7, 46, 54-55, 93-94, 129-131, 148, 174-175, 192-193, 198, 200, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin et al (Hereinafter referred to "Dworkin" U.S. Patent No. 6,026,148) in view of Uyama (U.S. Patent No. 5,819,267), and further in view of Stephanou (U.S. Patent No. 6,505,166).

As per claims 6-7, 46, 54-55, 93-94, 129-131, 148, 174-175, 192-193, 199, and 200, the combination of Dworkin and Uyama discloses the step of receiving a command (see claim 1 above), but fails to explicitly disclose receiving a command to refer the question to another one of the expert. Stephanou in the same field of endeavor, teaches an expert referral system for referring a question to another expert (col. 9, lines 1-32). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify the disclosures of Dworkin to include the expert referral system of Stephanou in order to respond to queries for help from customers who are in need.

5. Claims 8-9, 47-48, 56-57, 95-96, 155, 169-171, 173, 190-191 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin et al (Hereinafter refereed to as "Dworkin") in view of Uyama and further in view of Walker (U.S. Patent No. 5,862,223).

As per claims 8-9, 47-48, 56-57, 95-96, 155, 169-171, 173, 190-191, Dworkin fails to explicitly disclose receiving commands to edit answers. It was old and well known in the art at the invention was made to allow editing of answers posted to a database such as know-how database or more commonly a knowledge base of answers and that such systems existed at the time of the present invention being such feature. Therefore, it would have been obvious to a person of ordinary skill in the art at the time

of the invention to provide editing of the answers to update knowledge and to allow for the correction of errors to maintain the integrity of a know-how database.

As to attachments, Walker teaches the use of email system as a communication means between expert and user in an expert question/answer system such as taught by Dworkin and disclosed by the instant invention. It was old and well known in the art at the time the invention was made to attach files of additional materials images, documents, and multimedia files to emails to supplement the information provided in text form. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to provide attachments to experts' answers to supplement the response by email as suggested by Walker with additional information to thereby provide a more valuable answer to the user.

Remarks to Arguments

6. Applicant asserted (Amendment dated December 5, 2005) that Dworkin does not teach the claimed invention. Applicant further supported his assertion by arguing that there in no grouping of one or more questions directed to an expert upon generation of Fig. 6 of Dworkin. In response, the respectfully disagrees. Since Dworkin teaches the concept of a group of medical experts, grouping of one or more questions directed to an expert interface would have been obvious to a person of ordinary skill in the art with the motivation to allow an expert to answer more than one question at a time.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., while the Fig. 5 interface includes a filter component, it is does include a filter for

questions directed to an expert nor is such a filter made available upon generation of either the Fig. 5 or Fig. 6 interfaces) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Argument for the newly added claims 208-215 is moot because of the Election/Restriction.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Walker (W09804061) discloses a support expert-based commerce system for grouping questions to be sent and answered by an expert.

b. Altschuler et al (US Patent No. 5005143) discloses a system for predicting an expert decision.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (571) 272-6732. The examiner can normally be reached on Mon-Thurs 7:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RJ
May 30, 2006

Romain Jeanty
Primary Examiner
Art Unit 3623